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EXAMINER

YENKE, BRIAN P

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL D. ARLING and PATRICK H. HAYES

Appeal 2008-2829
Application 09/718,931
Technology Center 2600

Decided:¹ February 11, 2009

Before KENNETH W. HAIRSTON, ROBERT E. NAPPI,
and THOMAS S. HAHN, *Administrative Patent Judges*.

HAHN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants have requested a rehearing of our decision dated October 27, 2008, wherein we affirmed the anticipation and obviousness rejections of claims 6-9, 11, and 15-19.

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

We make the following additional findings of fact, in response to Appellants' arguments throughout the Request for Rehearing that the Board misapprehended or overlooked Appellants' argument that Hesse² under § 102 does not anticipate the claimed invention, because Hesse does not teach or suggest the recited element of starting a remote control timer in response to a user action.³

Appellants' invention as disclosed and claimed in the anticipation rejected claims is directed to a remote control for a media device. This claimed remote control responds to a "first predetermined user action" by storing a primary channel indicator in a memory, and uses a timer started in response to a "second predetermined user action" to determine expiration of a predetermined interval when a transmission is directed to the media device of a primary channel tuning signal (Representative claim 6).

Appellants argue throughout the Request for Rehearing that "Hesse does not disclose, teach, or suggest the claimed element for *starting a timer in response to a user action with a remote control.*" (Req. Reh'g 1). The verbatim claimed element referenced by Appellants from independent representative claim 6 is "starting the timer in response to a second predetermined user action." In order to construe this recited limitation, the Specification must be consulted to determine the broadest reasonable interpretation.⁴ Concerning a "predetermined user action," the Specification

² Hesse, U.S. Patent 5,287,109.

³ The Request for Rehearing is exclusively directed to the anticipation rejection of claims 6, 8, and 15-18. No argument directed to the obviousness rejection of claims 7, 9, 11, and 19 is set forth in the Request for Rehearing, and the Board, therefore, does not reconsider the obviousness rejection.

⁴ *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005).

alternatively discloses the “selecting [of] a key” or “depressing the same key . . . for [some] . . . duration, or it may be entirely different” (Spec. 4:20-30). There is no limitation recited in the anticipation rejected claims that sets out when this “second predetermined user action” is to occur in relation to any recited event other than starting the timer.

Hesse discloses a remote control 4 that can be used in manual or automatic modes by using a keypad 8 to input commands, such as channel information, and time of command information, i.e., time intervals, that are stored in a memory 18 so that command signals are transmitted from the remote control 4 when time of command information in the memory 18 matches times determined by a clock 20 (Abstract; col. 2, l. 34 to col. 3, l. 60; col. 4, ll. 19-27; Fig. 2). Inherently, upon the input to memory 18 of time command information, the Hesse clock 20 must be started and determining time. Otherwise, clock 20 – if not then started – would be incapable of determining when time of command information in memory 18 matches times to be determined by the same clock 20.

Appellants’ argument throughout the Request for Rehearing that Hesse neither teaches nor would have suggested to the skilled artisan the claim 6 limitation to “start[] the timer in response to a second predetermined user action,” we find to be contradicted by Hesse disclosing that the taught “remote control . . . can, by manual entries be programmed with specific user requests for different appliances to be operate[d] automatically at different times” (col. 3, ll. 24-28). Therefore, irrespective of automatic or manual mode of operation, Hesse teaches or would have suggested to the ordinarily skilled artisan that manual entries, i.e., “predetermined user action[s],” must be made to program the remote control 4. These memory

18 stored manual programming entries direct that times be measured using clock 20 in accord with input time commands to then consequently command transmission of command signals at predetermined intervals. It is irrelevant whether Hesse teachings do or do not eliminate any need to manually operate the taught remote control once it has been programmed, because there is no limitation recited in anticipation rejected claims that exclude automatic modes of operation or set out when this “second predetermined user action” is to occur in relation to any recited event other than starting the clock. Therefore, we conclude that manually programming the Hesse remote control for automatic mode operation with time commands and channel commands is read-on by the claim 6 recited limitations, including the first and second “predetermined user action[s].”

We are also not convinced by Appellants’ assertion that the Examiner acknowledged that “Hesse fails to explicitly disclose a remote control in which a user action starts a timer of the remote control . . .” (Req. Reh’g. 3, n. 1). What the Examiner acknowledged is that Hesse does not teach or suggest the obviousness rejected claim 7 recited limitations for transmission of a command signal in response “to the user repeating the second predetermined action prior to the predetermined interval expiring” (Ans. 6). These limitations set out a timing relationship between an antecedent recited event, i.e., expiration of the predetermined interval, and the user’s repeated second predetermined action. The anticipation rejected claims are silent with respect to such an order of events relationship, and also are silent with respect to the “user *repeating* the second predetermined action” (emphasis added).

In summary, we still maintain that Hesse teaches all of the structure set forth in claim 6, and that “Appellants have not shown that the Examiner erred in finding that the Hesse teachings anticipate representative claim 6 under § 102, or the other anticipation rejected claims 8, and 15-18” (Decision 15).

Appellants’ request for rehearing has been granted to the extent that our decision has been reconsidered, but such request is denied with respect to making any modifications to the decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REHEARING DENIED

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